REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed April 9, 2008. Through this response, claims 1, 14-16, 18-20, 23, and 27-28 have been amended, claims 2-13, 17, 21-22, 24-26, 29, 31, and 58-59 have been canceled without prejudice, waiver, or disclaimer, and claims 60-91 have been added. Reconsideration and allowance of the application and pending claims 1, 14-16, 18-20, 23, 27-28, 30, and 60-91are respectfully requested.

I. Claim Rejections - 35 U.S.C. § 102(e)

A. Statement of the Rejection

Claims 1-11, 14, 15, 17, 19-25, 29, 30, 58 and 59 have been rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by *Hunter et al.* ("*Hunter*," U.S. Pub. No. 2002/0056118). Applicants respectfully submit that the rejection to claims 1-11, 14, 15, 17, 19-25, 29, 30, 58 and 59 has been rendered moot. Further, Applicants respectfully submit that claims 1, 14-16, 18-20, 23, 27-28, 30, and 60-91 are allowable over *Hunter*.

B. Discussion of the Rejection

It is axiomatic that "[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983). Therefore, every claimed feature of the claimed invention must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. § 102(e).

In the present case, not every claimed feature is represented in the *Hunter* reference. Applicants discuss the *Hunter* reference and Applicants' amended claims in the following.

Independent Claim 1

Claim 1 recites (with emphasis added):

1. A recordable media content archiving system in a subscriber network, said recordable media content archiving system comprising:
a memory for storing recordable media content characterizing information;
a storage device configured for storing a plurality of portable storage mediums, wherein each portable storage medium is one of a plurality of different portable storage medium types; and
a processor configured with the memory to:
prior to a download of first recordable media content to be provided from a remote server and subsequent to a purchase of the first recordable media content:
receive into the memory first recordable media content characterizing information corresponding to the first recordable media content, the first recordable media content characterizing information including content type and subcategories of the content type; and
provide a user interface that identifies the first recordable media content and provides information about the first recordable media content, the user interface further including user-selectable lists each having plural entries, the user-selectable lists corresponding to content type, subcategories of the content type, and a choice of the plurality of portable storage mediums to download the first recordable media content, the content type user selectable list defaulting to a first entry based on the first recordable media content characterizing information associated with a type of content corresponding to the first recordable media content, the subcategory user selectable list defaulting to a second entry based on the first entry, and the choice of medium user selectable list defaulting to a third entry based on the first and second entries; and
responsive to receiving a download of the first recordable media content via the subscriber network from the remote server, the processor is further configured with the memory to ***store the first recordable media content to the portable storage medium corresponding to the third entry***.

Applicants respectfully submit that the rejection to claim 1 has been rendered moot. Further, Applicants respectfully submit that claim 1 is allowable over *Hunter* for at least the reason that *Hunter* fails to disclose, teach, or suggest at least the above-emphasized claim features. For instance, paragraph [0012] of *Hunter*, reproduced in part below, discloses that

the purchase of recorded content occurs post-download, not pre-download (emphasis added):

> In preferred embodiments, video/audio content is blanket transmitted via direct broadcast satellite (DBS) in an encoded, compressed form for playback at VHS resolution (or other desired resolution). The transmission is directly to each customer's receiving dish or antenna which is linked to the customer's user station where selected movies are stored on DVD RAM discs or CD's in a multiple disc platter, or on a hard drive having a storage capacity of, for example, 20 gigabytes or more. The movies may then be played immediately or at any time desired by the consumer, with the consumer paying only for those movies that are actually viewed.

Accordingly, it cannot be said that *Hunter* discloses, teaches, or suggests a pre-download, post-purchase operation of receiving ***into the memory first recordable media content characterizing information corresponding to the first recordable media content***. Further, assuming *arguendo* that *Hunter* discloses an equivalent to the characterizing information, it appears that paragraph [0065] of *Hunter* would suggest that such information would be transmitted in the header of the data stream during the download of content (and hence before purchase), and not before downloading the content. As set forth in paragraph [0065] of *Hunter* (emphasis added):

> [0065] Encoded programming data as a datastream via satellite downlink through antenna 24 is transmitted to a decoder 82. Decoder 82 looks for headers in the datastream indicating movies or other content that have been preselected for recording. The programming data includes video/audio content data, content availability/scheduling data and content pricing data. Decoded preselected movie data is transmitted via CPU 80 to a high speed memory buffer 84 (with or without high capacity storage capability) and then written to a high density record/playback drive 86, such as a DVD drive associated with the DVD platter 46. In certain embodiments, the high speed memory buffer 84 may utilize a magnetic drive, a magneto-optical drive, an optical drive, or other suitable drive. Buffer 84 may utilize DRAM, flash memory, SRAM or other suitable memory media such as digital tape.

The Office Action appears to equate the claimed user interface to that shown in Figures 5 and 7 of *Hunter*. Figure 5 of *Hunter* appears to have an option to select programs

recorded for viewing (further shown in Figure 6), which evidently requires the user interface of *Hunter* to be presented after download of the content. Likewise, *Hunter* describes transmitting the new releases before actual purchase (e.g., see paragraph [0017] of *Hunter*).

Additionally, none of the user interfaces in *Hunter* disclose the claimed user interface features of claim 1. Accordingly, for at least the reasons set forth above, Applicants submit that claim 1 is allowable over *Hunter*, and respectfully request that the rejection be withdrawn.

Because independent claim 1 is allowable over *Hunter*, dependent claims 14, 15, 19, 20, 23-25, and 30 are allowable as a matter of law for at least the reason that the dependent claims 14, 15, 19, 20, 23-25, and 30 contain all elements of their respective base claim. See, *e.g.*, *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Due to the shortcomings of the *Hunter* reference described in the foregoing, Applicants respectfully assert that *Hunter* does not anticipate Applicants' claims. Therefore, Applicants respectfully request that the rejection of these claims be withdrawn.

II. Claim Rejections - 35 U.S.C. § 103(a)

A. Statement of the Rejection

Claims 12, 13, 16 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Hunter* in view of *Hassell et al.* ("*Hassell*," U.S. Pub. No. 2004/0128685). Claims 18 and 26 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Hunter* in view of *LaJoie et al.* ("*LaJoie*," U.S. Pat. No. 5,850,218). Claims 27 and 28 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Hunter* in view of *Browne et al.* ("*Browne*," WO 92/22983). Claim 31 has been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Hunter* in view of *Russo* ("*Russo*," U.S. Pat. No.

5,619,247). Applicants respectfully traverse these rejections to the extent not rendered moot by amendment.

B. Discussion of the Rejection

The M.P.E.P. § 2100-116 states:

> Office policy is to follow *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), in the consideration and determination of obviousness under 35 U.S.C. 103. . . the four factual inquires enunciated therein as a background for determining obviousness are as follows:
>
> (A) Determining the scope and contents of the prior art;
> (B) Ascertaining the differences between the prior art and the claims in issue;
> (C) Resolving the level of ordinary skill in the pertinent art; and
> (D) Evaluating evidence of secondary considerations.

In the present case, it is respectfully submitted that a *prima facie* case for obviousness is not established using the art of record.

Claims 12, 13, and 16

The rejection to claims 12 and 13 has been rendered moot by claim cancellation. Additionally, as set forth above, Applicants respectfully submit that claim 1 is allowable over *Hunter*. *Hassell* does not remedy the deficiencies of *Hunter*. For at least the reason that claim 16 depends from allowable claim 1, Applicants respectfully request that the rejection be withdrawn.

Claims 18 and 26

The rejection to claim 26 has been rendered moot by claim cancellation. Additionally, as set forth above, Applicants respectfully submit that claim 1 is allowable over *Hunter*. *LaJoie* does not remedy the deficiencies of *Hunter*. For at least the reason that claim 18 depends from allowable claim 1, Applicants respectfully request that the rejection be withdrawn.

Additionally, addressing the pre-download purchase feature of amended claim 1 (as incorporated into claim 18), Applicants respectfully submit that the combination of *Hunter* and *LaJoie* is not obvious. The Office Action (page 13) acknowledges that *Hunter* does not "disclose purchasing the first recordable media content prior to downloading," yet alleges that *LaJoie* discloses this feature and that it "would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hunter et al. to include a user input for purchasing an event prior recording, such as that taught by LaJoie et al. in order to save storage space." Applicants respectfully disagree. The entire focus of *Hunter* is on local storage and playback by the user at the user's convenience for viewing (and hence purchase). Impulse pay-per-view is neither mentioned nor warranted in the system of *Hunter*, especially in view of the "New Releases" aspect of *Hunter*, which enables a user to view at his or her convenience new releases without the scheduling constraints of a provider. Indeed, combining the pre-download impulse-pay-per view purchases of *LaJoie* is at odds with the principle of operation of the system in *Hunter*, and accordingly, represents a combination that is contrary to Patent Office guidelines and well-established federal case law, reproduced in part below (MPEP 2143.01):

> If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)

Accordingly, for this additional reason, Applicants respectfully request that the rejection be withdrawn.

Claims 27 and 28

The rejection to claims 27 and 28 has been rendered moot by claim amendments set forth above that distinguish over the type of "lock" presented in *Browne*.

Additionally, as set forth above, Applicants respectfully submit that claim 1 is allowable over *Hunter*. *Browne* does not remedy the deficiencies of *Hunter*. For at least the reason that claims 27 and 28 depend from allowable claim 1, Applicants respectfully request that the rejection be withdrawn.

Claim 31

The rejection to claim 31 has been rendered moot by claim cancellation.

III. Canceled Claims

As identified above, claims 2-13, 17, 21-22, 24-26, 29, 31, and 58-59 have been canceled from the application through this response without prejudice, waiver, or disclaimer. Applicants reserve the right to present these canceled claims, or variants thereof, in continuing applications to be filed subsequently.

IV. New Claims

As identified above, claims 60-91 have been added into the application through this response. Applicants respectfully submit that these new claims describe embodiment(s) that are novel and unobvious in view of *Hunter*, *Hassell*, *LaJoie*, and *Browne*. For instance, *Hunter*, *Hassell*, *LaJoie*, and *Browne*, alone or in combination (assuming proper combination), fail to disclose, teach, or suggest at least "prior to a download of first recordable media content to be provided from a remote server and subsequent to a purchase of the first recordable media content: receiving into memory first recordable media content characterizing information corresponding to the first recordable media

content, the first recordable media content characterizing information including content type and subcategories of the content type; and providing a user interface that includes the identity of the first recordable media content and information about the first recordable media content, wherein the user interface further includes user-selectable lists each having plural entries, the user-selectable lists corresponding to content type, subcategories of the content type, and a choice of the plurality of portable storage mediums to download the first recordable media content, the content type user selectable list defaulting to a first entry based on the first recordable media content characterizing information associated with a type of content corresponding to the first recordable media content, the subcategory user selectable list defaulting to a second entry based on the first entry, and the choice of medium user selectable list defaulting to a third entry based on the first and second entries; and responsive to receiving a download of the first recordable media content via the subscriber network from the remote server, storing the first recordable media content to the portable storage medium corresponding to the third entry," as set forth in whole or in part in independent claims 76 and 91 (and incorporated into dependent claims 77-90). Therefore, Applicants respectfully request that these claims be held to be allowable.

IV. Information Disclosure Statement

Applicants have submitted with this response art cited in a co-pending related case having serial number 09/896,231 (currently under petition for revival) and a copy of the Board's Decision in that case, as well as art cited in a related case that has issued as U.S. Patent no. 6,760,918.

CONCLUSION

Applicants respectfully submit that Applicants' pending claims are in condition for allowance. Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, and similarly interpreted statements, should not be considered well known since the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

/dr/
David Rodack
Registration No. 47,034

THOMAS, KAYDEN,
HORSTEMEYER & RISLEY, L.L.P.
Suite 1500
600 Galleria Parkway N.W.
Atlanta, Georgia 30339
(770) 933-9500